

REMARKS

At the time of the Final Office Action dated December 19, 2006, claims 1-5, 7-10, and 12-14 were pending and rejected in this application. Independent claims 1, 5, and 10 have been amended. Specifically, Specifically, claims 5 and 10 have been amended by incorporating the limitations of claims 9 and 14, respectively, therein, and consequently claims 9 and 14 have been cancelled. Claim 1 has been amended by incorporating the limitations of claims 2 and 3, and consequently, claims 2 and 3 have been cancelled. Claims 8 and 13 have also been cancelled.

Applicants submit that the present Amendment does not generate any new matter issue. Moreover, Applicants note that the present amendments to the claims do not raise any new issues since the amendments to the claims were only to include limitation previously presented and examined by the Examiner.

Applicants respectfully submit that by the present Amendment and Remarks, this application is placed in clear condition for immediate allowance. At the least, the number of issues have been reduced, thereby placing this application in better condition for Appeal.¹ Accordingly, entry of the present Amendment and Remarks and favorable consideration are respectfully solicited. If the Examiner refuses to enter the present Amendment, Applicants request that the Examiner check box 7(b) in form PTOL-303 (Advisory Action), which states that for purposes of Appeal, Applicants' proposed amendments will be entered since, as noted above, the present Amendment reduces the number of issues for Appeal.

¹ See M.P.E.P. § 706.07(e) ("An amendment that will place the application ... in better form for appeal may be admitted.").

APPLICANTS REQUEST WITHDRAWAL OF THE FINALITY OF THE PRESENT OFFICE

ACTION

Applicants submit that the present Office Action dated December 19, 2006, has improperly been designated as final. In the statement of the rejection, the Examiner cited M.P.E.P. § 706.07(a) as the basis for making the present Office Action final and stated: "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." However, M.P.E.P. § 706.07(a) clearly states:

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. (emphasis added)

In the Office Action dated August 1, 2006, the Examiner rejected dependent claims 6 and 11 under 35 U.S.C. § 102 for anticipation based upon Fellenstein. In the Amendment filed November 1, 2006, the limitations previously presented in dependent claims 6 and 11 were incorporated, respectively, into independent claims 5 and 10. Therefore, the amendment to claims 5 and 11 did not raise any new issues, and these claims are deemed not amended since the limitations contained therein have already been presented and examined.

However, in the present Office Action, claims 5 and 10 are rejected under 35 U.S.C. § 102 for anticipation based upon Goldberg. Thus, the Examiner has rejected claims 5 and 10, which are deemed not amended, on newly cited art (i.e., Goldberg). Therefore, despite the amendments to claim 1, it is improper under M.P.E.P. § 706.07(a) for the Examiner to designate the present Office Action as final. On this basis, Applicants respectfully solicit withdrawal of the finality of the present Office Action.

**CLAIMS 1-2, 4-5, 7-8, 10, AND 12-13 ARE REJECTED UNDER 35 U.S.C. § 102 FOR
ANTICIPATION BASED UPON GOLDBERG, U.S. PATENT NO. 6,331,817**

On pages 2 and 3 of the Office Action, the Examiner asserted that Goldberg discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

At the outset, Applicants note that independent claims 1, 5, and 10 have been amended to include the limitations respectively recited in claims 3, 9, and 14, which the Examiner admits is not identically disclosed by Goldberg within the meaning of 35 U.S.C. § 102. Therefore, for the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1, 4-5, 7, 10, and 12 under 35 U.S.C. § 102 for anticipation based upon Goldberg.

**CLAIMS 3, 9, AND 14 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON GOLDBERG IN VIEW OF FELLENSTEIN ET AL., U.S. PATENT NO. 6,747,555 (HEREINAFTER
FELLENSTEIN)**

On pages 3 and 4 of the Office Action, the Examiner asserted that Goldberg discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

As already noted above, independent claims 1, 5, and 10 have been amended to include the limitations respectively recited in claims 3, 9, and 14. Although Applicants disagree that the claimed invention is obvious based upon the Goldberg in view of Fellenstein, to expedite prosecution of the Application, Applicants submit that the reference to Fellenstein cannot be properly applied against the present Application under 35 U.S.C. § 103.

As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention. See M.P.E.P. § 706.02(I).

**Application No. 10/663,947 (the present application) and
U.S. Patent No. 6,747,555 (Fellenstein) were, at the time the
invention was made, commonly owned by International Business
Machines Corporation**

Thus, under 35 U.S.C. § 103(c), the reference to Fellenstein cannot be considered by the Examiner when determining whether Applicants' invention is obvious under 35 U.S.C. § 103. Applicants, therefore, respectfully submit that a rejection of claims 1, 5, and 10 under 35 U.S.C. § 103 for obviousness based upon the Goldberg in view of Fellenstein would not be viable.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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